

REMARKS

Claims 1 through 15 and 53 through 84 are presented. Claims 16 through 37 and claims 42 through 52 are cancelled in this Amendment, and claims 38-41 were cancelled in a previous Amendment. For ease of reference, claims 16 through 37 and 42-43, 45-52 are renumbered and submitted variously as new claims 53 through 84. At least some of these renumbered claims have also been amended.

Specifically, cancelled claims 29 through 37 have been associated with new claims 53-61; cancelled claims 42-44 are associated with new claims 62-64; cancelled claims 16-19 are associated with new claims 65-68; cancelled claims 48 -51 are associated with new claims 69 - 72; cancelled claims 20- 8 are associated with new claims 73-81; and cancelled claims 52, 45 and 47 are associated with new claims 82-84, respectively.

Claim 1, new claim 65 (corresponding to cancelled claim 16), new claim 66, (corresponding to cancelled claim 17), new claim 73 (corresponding to cancelled claim 20), new claim 74 (corresponding to cancelled claim 21), and new claim 82 (corresponding to cancelled claim 52) are the independent claims herein. No new matter has been added.

Claims 1, 2, 5, 7-10, 14-15, 17, 19-23 and 52 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,831,531 to Tuttle (“Tuttle”). Claims 3-4, 11-13, and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tuttle in view of U.S. Patent No. 5,859,415 to Blomqvist *et al.* (“Blomqvist”). Claims 6 and 44-51 are rejected under 35 U.S.C. §103(a)s being unpatentable over Tuttle in view of U.S. Patent No. 6,507,275 to Romano *et al.* (“Romano”). Claims 18 and 24-37 are rejected as being unpatentable over Tuttle in view of Patent No. 5,798,694 to Reber *et al.* (“Reber”). Claims 42 and 43 are rejected as being unpatentable over Tuttle in view of U.S. Patent No. 6,578,199 to Tsou *et al.* (“Tsou”). For ease of explanation, when discussing independent claims, both the cancelled claim number and the corresponding new claim number will be given for ease of cross referencing.

Applicant hereby requests reconsideration and withdrawal of the above rejections and requests issuance of the new claims in light of the foregoing amendments and the follow remarks.

Independent claim 1 is directed to a method of monitoring a container associated with an item. An indication is received that the container has been opened. It is then arranged for ownership of the item to be transferred based on the indication that the container has been opened.

For example, in some possible embodiments in the specification, as discussed regarding FIG. 7:

At 704, it is arranged for ownership of the item to be transferred based on the received indication. For example, ownership may be transferred to the person who opened the container. Ownership may also be transferred to a party associated with the person who opened the container. For example, ownership of the item may be transferred to the employer of the person who opened the container. (Application, page 13, lines 8-13).

The art of record is not seen to disclose or suggest the above features of claim 1. In particular, the art of record is not seen to disclose or suggest arranging for ownership of an item to be transferred based on an indication that the container has been opened.

In the Office Action, it is stated that "Tuttle fails to teach arranging for ownership of the items to be transferred based on the indication [that the container has been opened]." (Office Action, page 2). Applicant agrees with the Office Action. However, then the Office Action says that "Official Notice is taken that the concept of arranging of ownership of the item to be transferred based on the indication [that the container has been opened] is well known as expected in the art." (Office Action, page 2).

Applicant respectfully traverses the above Official Notice, and challenges the above factual assertion made by the Examiner that the concept of arranging of ownership of an item to be transferred based on the indication is well known as expected in the art. Applicant hereby requests documentary evidence supporting the above Official Notice either in the form of cited art, or alternatively an affidavit under 37 CFR §1.104(d)(2), as will be detailed below.

The standard of review applied to findings of fact made by the U.S.P.T.O. is the "substantial evidence" standard under the Administrative Procedure Act. Please see M.P.E.P. §1216.01. Under the "substantial evidence" standard, M.P.E.P. §2144.03(A) states:

Official Notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances ... It would not [emphasis in *original*] be appropriate for the examiner to take official notice of facts without

citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstrations as being well known... As the court held in Zurko, [258 F.3d at 1385, 59 USPQ 2d at 1697], an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support...

and, therefore, the Official Notice without documentary evidence fails the substantial evidence test necessary for sustaining a rejection.

M.P.E.P. §2144.03(C), entitled If Applicant Challenges a Factual as Not Properly Officially Notice or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence, states:

If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained.... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

CFR §1.104(d)(2) states, in part, that "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit or such employee..."

Applicant hereby states that the Official Notice made within the Office Action is based upon the personal knowledge of the Examiner, as it is not supported by substantial documentary evidence found within the record. Applicant therefore requests that documentary evidence be produced by the Examiner, either in the form of cited art or in the form of a personal affidavit, meeting at least the above requirements.

The remaining art of record has been reviewed and is not seen to remedy the deficiencies of Tuttle or the Official Notice, either singularly or in combination. Therefore, the art of record, taken in any permissible combination, is not seen to disclose or suggest arranging for ownership of an item to be transferred based on an indication that the container has been opened.

In view of the foregoing, independent claim 1 is believed to be in condition for allowance. Claims 2-15 and 53-64 depend from claim 1, and are therefore also believed to be allowable for at least the foregoing reasons.

New independent claim 65 (corresponding to cancelled claim 16), new independent claim 66 (corresponding to canceled claim 17), new independent claim 73 (corresponding to cancelled claim 20), and new independent claim 74 (corresponding to cancelled claim 21) relate, respectively, to a computer implemented method, an apparatus, a medium storing instructions adapted to be executed by a processor to perform a method, and a method, to arrange for ownership of an item associated with a container or package to be transferred based on an indication that the container or package has been opened.

In view of the foregoing, new independent claims 65, 66, 73 and 74 are also believed to be in condition for allowance. Dependent claims 67-72 and 75-81 depend from independent claims 66 and 74, and are therefore also believed to be allowable for at least the foregoing reasons.

New independent claim 82 (corresponding to cancelled claim 52) is directed to a method. In claim 82, it is arranged for an item to be within a container. A signal is received that indicates that the container has been opened, it is verified that the container was opened in accordance with an item requirement. The item requirement includes a requirement that no more than a selected number of items have been opened in a selected time period.

The art of record is not seen to disclose the above features of independent claim 82. In particular, the art of record is not seen to disclose or suggest verifying that a container was opened in accordance with an item requirement.

For example, in some exemplary embodiments of the present application:

The received indication may include, for example, a container identifier, an item identifier, and/or an item category. ...If the container was opened in accordance with an item requirement at 1404 (e.g., indicating that no more than three containers may be opened in a twenty-four hour period), the process ends at 1406. If the container was not opened in accordance with the item requirement, an alert is transmitted at 1408. The alert may be transmitted to, for example, a person who opened the container, a party associated with the item, and/or a third party (e.g., a doctor).

By way of example, Helen receives ten packets of medication (each containing a single pill) associated with a medical treatment program. She is told to take one pill each day for the next ten days. Each time Helen opens a packet, the packet transmits a signal that is received by the controller 1500. When Helen forgets to take a pill on the eighth day of the program (i.e., as indicated by the fact that no packet was opened – and therefore no signal was received by the controller 1500),

an alert is transmitted to Helen and her doctor. (Present application, page 21, lines 3-21).

The art of record is not seen to disclose or suggest the above features of amended independent claim 82. In particular, the art of record is not seen to disclose or suggest *verifying that a container was opened in accordance with an item requirement*.

The Examiner has indicated that column 3, lines 56-67, Romano teaches verifying that a container was opened in accordance with an item requirement. Column 3, lines 56-67 of Romano state:

A warning indicator is energized by microprocessor 20 and may output a signal at a time when a medicament is to be taken. The signal may be an audible alarm, a luminous alarm (such as LED 27 or a luminous LCD), a vibrating alarm, or any combination of the three, which work in conjunction with a data display window 28. A second data display window 29 is a time display unit, which, of course, may be on the same screen as data display window 28. Preferably, the data display window is a liquid crystal display unit and is capable of outputting the name of the drug and, preferably, conditions ...

Applicant respectfully does not understand how this passage discloses *verifying that a container was opened in accordance with an item requirement*. Although the cited passage of Romano discusses a "warning indicator" that "may output a signal at a time when a medicament is to be taken," the cited passage of Romano concerns itself with outputting the alarm. Romano does not disclose or suggest *verifying that a container was opened in accordance with an item requirement*.

Furthermore, the art of record is not seen to disclose or suggest other features of amended claim 82. In particular, the cited art of record is not seen to disclose *wherein the item requirement includes a requirement that no more than a selected number of a plurality of containers, each containing an associated item, have been opened in a selected time period*.

In Tuttle, an RFID is used in the event that a shipping container is opened without authorization. However, nowhere in Tuttle is there a disclosure or suggestion of an item requirement that includes a requirement that no more than a selected number of a plurality of containers, each containing an associated item, have been opened in a selected time period.

Nor does Romano compensate for the deficiencies of Tuttle. Romano is purportedly capable of generating an alert signal indicating when medication is to be taken. (Column 4, lines 18-19). However, nowhere in Romano is there a disclosure or suggestion of an item requirement that includes a requirement that no more than a selected number of a plurality of containers, each containing an associated item, have been opened in a selected time period.

The remaining art of record has been reviewed and is not seen to remedy the deficiencies of Tuttle, the Official Notice, or Romano. Therefore, the art of record, taken in any permissible combination, is not seen to disclose or suggest *verifying that a container was opened in accordance with an item requirement*. Nor is the art of record, taken in any permissible combination, seen to disclose or suggest that the item requirement includes a requirement that no more than a selected number of containers, each containing an associated item, have been opened in a selected time period. In view of the foregoing, independent claim 82 is believed to be in condition for allowance. Claims 83 and 84 depend from claim 82 and are therefore also believed to be allowable for at least the foregoing reasons.

Furthermore, Applicant's silence in the present Amendment regarding various arguments, objections or rejections of the present Office Action does not necessarily signify an agreement or acquiescence with the various arguments, objections or rejections arguments, especially as to those various arguments, objections or rejections that were previously addressed in the previous Amendment.

CONCLUSION

Accordingly, Applicant respectfully requests allowance of the pending claims. If any issues remain, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is kindly invited to contact the undersigned via telephone at (203) 972-4982.

Respectfully submitted,

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